

SN 09/627,753

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TECH CENTER 1600/2900 Case No. 1264C5
TECH CENTER 1600/2900

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Livak et al.

Serial No.: 09/627,753

Filed: July 28, 2000

For: **Hybridization Assay Using Self-
Quenching Fluorescence Probe**

) Group Art Unit: 1656

) Examiner: J. Riley

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

may 14, 2001
Date of Deposit

Mila T. Kasan
Name of Depositing Party

[Signature]
Signature of Depositing Party

RESPONSE UNDER 37 CFR 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

With reference to the Office action mailed November 14, 2000, reconsideration of the application is respectfully requested. Claims 39-40 are pending.

I. Information Disclosure Statements

Reference is made to the Information Disclosure Statement submitted by mail to the Patent Office on November 8, 2000, and for which a date-stamped receipt postcard has been received (copy will be provided upon request). In addition, a Supplemental Information Disclosure Statement is enclosed herewith. Acknowledgment of these Information Disclosure Statements by the Examiner is respectfully requested.

II. Rejection Under 35 U.S.C. 112, Second Paragraph

Claims 39-40 were rejected as allegedly being indefinite because of the phrase "under conditions *favorable* for hybridization" (emphasis added to highlight "favorable", which was omitted from the Office action).

To meet the definiteness requirement of 35 U.S.C. 112, a claim is definite if its metes and bounds would be clear to one of ordinary skill in the art. In the present case, reading claim 39 as a whole, the phrase "under conditions favorable for hybridization" would be understood to mean that the oligonucleotide probe is able to hybridize to an intended target polynucleotide such that the fluorescence of the reporter molecule in the probe increases upon hybridization to the target, indicating that the target is present. It is respectfully submitted that express recitation of conditions of high or low stringency is not required. Accordingly, withdrawal of the rejection is requested.

III. Rejections Under 35 U.S.C. 102(a)/(b)

Claims 39-40 were rejected as allegedly being anticipated by:

102(a): Livak et al., PCR Methods and Applications, pp. 357-362, 1995

102(b): Bagwell, EP 601889 A2, 1994

102(b): Lee et al., Nucl. Acids Res. 21:3761-3766, 1993

102(b): Heller et al., EP 229943, 1987

To be anticipatory, a reference must show each and every element of a claimed invention. In the present case, the Examiner has not pointed to any teaching of use of an oligonucleotide probe attached to a solid support in a method in accordance with claims 39-40. Accordingly, the rejection should be withdrawn.

IV. Obviousness-Type Double Patenting Rejection

The claims were rejected over the claims in Patent Nos. 5,876,930 and 6,030,787. It is requested that this rejection be held in abeyance until allowable subject matter is indicated by the Examiner.

V. Fee Authorization

Should any fee be necessary with this paper, please charge **Deposit Account No. 01-2213**. Any deficiency or overpayment should be charged or credited to this deposit account.

Respectfully submitted,

Date: _____

May 14, 2001

Vincent M. Powers
Vincent M. Powers
Reg. No. 36,246

CORRESPONDENCE ADDRESS

Applied Biosystems
850 Lincoln Centre Drive
Foster City, California 94404
TEL: 650-638-6492
FAX: 650-638-6677